

## **REMARKS**

Claims 1-11 remain in this application for examination.

### **Drawings:**

Applicant proposes to add reference numeral 10 to Fig. 1.

### **Specification:**

Applicant has deleted two sentences in the original Abstract of the Disclosure so that the Abstract of the Disclosure is now less than 150 words.

### **Claim Objections:**

The term "an" has been added before the term "annular" in lines 6 and 7 of claim 1.

### **Claim Rejections Under 35 U.S.C. §102:**

Claims 1-11 have been rejected under 35 U.S.C. §102(b) as anticipated by Hultgren et al. '666. Applicant respectfully traverses this rejection. As the Examiner realizes, Hultgren discloses a structure which is different from Applicant's invention because in Hultgren, the combination filter element support 48 and anti-prefill valve 76 are made of separate pieces, the support 48 being made of metal and the anti-prefill valve 76 being made of rubber.

In Applicant's claimed invention, a combination filter element support and anti-prefill valve are configured from unitary body made of a single piece, rather than an integrated

body made of more than one piece. Excluding the bypass valve 64 and the bypass spring 66 of Hultgren, there are still at least 4 separate elements comprising the valve assembly 46, i.e. the sleeve 52, the support member 48, the anti-drainback valve 46 and the L-shaped reinforcement member 92. Applicant has but a single element 12 which forms a combination filter element support and anti-prefill valve. The advantages of the single element 12 are set forth in the Applicant's background of the Invention as follows:

During manufacture, when disparate parts are matched, the risk of failure is increased because one of the parts may be of inferior quality and adversely effect the reliability of the entire assembly. It is frequently time consuming and therefore costly to assemble the plurality of elements in order to configure an item reliably. Consequently, utilizing only a single element can be advantageous. This is especially the case with mass produced items such as filters for engine lubricating oil which are manufactured by the millions.

An assembly which makes an element "unitary," as disclosed and claimed by Applicant, is not a distinction without a difference.

Patent law obtains that there is a difference between the concepts of "unitary" and integral. Therefore this rejection under 35 U.S.C. §102(b) should be withdrawn.

Moreover, Applicant's claimed invention is directed to solving a different problem in that Applicant's claimed invention is an anti-prefill valve, which discourages a retail business from filling new filters with used or cheap lubricating oil in order to make undeserved profits at the customer's expense. Hultgren et al. is directed to a different problem, i.e. preventing oil left in a filter when the engine is turned off from leaking back out of the filter, so that for a short period of time, the engine may be starved of oil when it starts. There is nothing in Hultgren et al. about prevention of prefilling filters.

In the Examiner's note, the Examiner refers to the valve 78 of Turman '564. Applicant respectfully submits that this is anything but an anti-prefill valve because it is oriented in a direction opposite the anti-prefill valve of Applicant. It is very easy to prefill the filter of Turman with used or cheap oil by simply pumping the oil in through the inlet 16 so as to open a valve 78 and allow the oil to flow into the chamber of the housing 50 containing the filter media 66. The valve 78 would then keep the oil in the housing instead of allowing the housing to empty. Clearly Turman '564 is antithetical to Applicant's claimed invention.

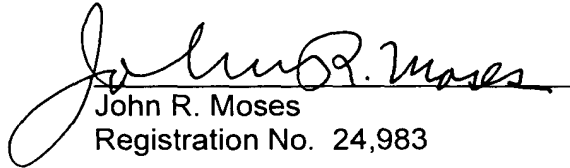
**Double Patenting:**

Claims 1, 2, 9 and 11 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatenable over claims 10, 13 and 14 of co-pending application serial no. 09/965,805. This application was filed on even date with the present application so these two applications will expire on the same day. Applicant submits herewith a Terminal Disclaimer which negates both this rejection and the rejection of claims 3-8 and 10 as being unpatentable over these same claims of copending application '805 in view of Hultgren.

In that this is a full and complete response to the Office Action of October 23, 2002, this application is now in condition for allowance. If the Examiner for any reason feels a personal conference with Applicants' attorneys might expedite prosecution of this application, the Examiner is respectfully requested to telephone the undersigned locally.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE SPECIFICATION:**

Please **amend** the specification as follows:

**On page 1, the first full paragraph has been amended as follows:**

This application is related to U.S. patent application Serial No. 09/965,805, filed October 1, 2001, ~~Our docket No. Dana-139~~, filed on even date herewith, entitled "Three Valve Filter Element Support for Filter Cartridge," and incorporated herein by reference in its entirety.

**IN THE CLAIMS:**

Please **am nd** claim 1 as follows:

1. (Amended) A combination filter element support and anti-prefill valve for use with an annular filter element having an annular filter media with a hollow core and disposed within a housing, wherein the housing is closed by an end plate having a central spin-on outlet opening and a plurality of spaced radially disposed inlets, the combination comprising:

a unitary body having an annular portion wherein the annular portion has an annular shoulder extending radially therefrom for supporting the filter element, and a sealing section which engages the end plate over a continuous location which is coaxial with the central spin-on opening, and

the unitary body including a radially extending plate portion having an axially positioned one way valve unitary therewith which opens in an axial direction toward the spin-on opening, the one way valve closing to prevent oil or fuel from flowing through the central spin-on opening and into the hollow core of the filter element and opening when fluid is being circulated is under pumping pressure.